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PATENT APPLN. NO. 10/516,621  
RESPONSE UNDER 37 C.F.R. § 1.116

PATENT  
FINAL

REMARKS

Claims 6 to 11 stand rejected as being obvious over Ashihara et al. (U.S. Patent No. 6,277,912; hereinafter "Ashihara") in view of Verardi et al. (U.S. Patent No. 5,863,646; hereinafter Verardi). Verardi does not teach that an aromatic solvent and an ethereal solvent are functionally equivalent in a process for preparing an aqueous resin dispersion composition as disclosed in Ashihara.

- (1) VERARDI DOES NOT TEACH THAT AN AROMATIC SOLVENT AND AN ETHEREAL SOLVENT ARE FUNCTIONALLY EQUIVALENT IN A PROCESS FOR PREPARING AN AQUEOUS RESIN DISPERSION COMPOSITION AS DISCLOSED IN ASHIHARA

In response to the rejection of the claims over Ashihara in view of Verardi, applicants have previously explained that the Office has not shown that Verardi teaches that an aromatic solvent and an ethereal solvent are functionally equivalent in a process for preparing an aqueous resin dispersion composition as disclosed in Ashihara.

In the present Action, the Office takes the position that applicants' argument that Verardi does not teach that an aromatic solvent and an ethereal solvent are functionally equivalent in a process for preparing an aqueous resin dispersion composition as disclosed in Ashihara is not persuasive because Verardi in Col. 6, lines 42-44 and 50-55, teaches "aromatic solvents and ethereal

solvents are suitable as solvents for the disclosed composition".  
(Action, page 5, lines 6-7).

The Office is wrong. The description in Col. 6, lines 42-44 and 50-55, of Verardi is not a teaching of the functional equivalence of aromatic solvents and ethereal solvents in a process for preparing an aqueous-based composition. The first part of the sentence beginning in line 42 of Col. 6 of Verardi describes that "[t]he coating composition, WHEN SOLVENT-BASED, may contain suitable solvents." (Emphasis applicants').

For this reason the rejection is improper and should be removed.

The Office, if it maintains the 35 U.S.C. § 103(a) rejection of claims 6 to 11 over Ashihara in view of Verardi, is respectfully requested to explain how teachings relating to solvents useful in solvent-based coating composition support an equivalence of the same solvents in aqueous-based coating compositions.

- (2) THE CLOSEST PRIOR ART IS NOT REQUIRED TO BE PRIOR ART CITED BY THE OFFICE

In the previous office action of December 21, 2005, the Office, while acknowledging that the process step sequences of Ashihara and of the process recited in claims 6 to 11 of the present invention are different, i.e., whereas Ashihara neutralizes the dispersion after water is added, in the process recited in

claims 6-11 the acid-modified chlorinated polyolefin is neutralized prior to the addition of water as a dispersion medium, took the position that "since applicant has not demonstrated the criticality of the process sequence, the selection of any order of performing process step is *prima facie* obvious in the absence of new or unexpected results" (page 6, third paragraph, of the Action).

In response to this position, applicants submitted a Declaration (under 37 C.F.R. § 1.132) of Tatsuo TSUNEKA with the response of May 22, 2006, which shows the criticality of the process sequence recited in claims 6-11.

In the Action dated July 25, 2006, the Office took the position that the comparative data in the declaration are not sufficient to overcome the rejection of claims 6-11 because the data do not provide a comparison with Ashihara.

In response to this position applicants, in the paper filed October 25, 2006, argued that the process of Example 6 of Ashihara is not the closest prior art because the example does not use an ethereal solvent whereas the comparative examples in the declaration use an ethereal solvent and an acid-modified chlorinated polyolefin within the scope of the claims of the application. In the declaration, only the sequence of steps differs from that of the process recited in claims 6-11 of the application. Therefore,

the comparative experiments represent the closest possible prior art.

In the present action, the Office has again refused to give full weight to the data of the declaration. The Office's reasons are as follows:

"Regarding applicants' arguments that the reference, Ashihara et al., is not the closest prior art because it does not use an ethereal solvent, the examiner disagrees. Because the 103 rejection set forth relies on Ashihara et al., Ashihara et al. is the closest prior art on record. To obtain a valid patent, instead of arguing that the reference to Ashihara is not the closest prior art, applicants should submit comparative data to show that it is not possible to obtain a dispersion from the teachings of Ashihara et al. in the absence of ethereal solvent."

The data in a declaration under 37 C.F.R. § 1.132 are not required to provide a comparison with the closest prior art of record, the data are required to provide a comparison with the closest prior art. MPEP 716.02(e)(I) explicitly provides that, "[a]pplicants may compare the claimed invention with prior art that is more closely related to the invention than the prior art relied upon by the examiner." In the present case, applicants have established the criticality of the claimed sequence of steps by providing comparative data for a process that differs from the present invention only in the sequence of steps. The process of Ashihara, which differs from the present invention in both the sequence of steps and the lack of an ethereal solvent, is further

from the present invention than the process reported in the declaration under 37 C.F.R. § 1.132.

The Office's continued refusal to give full weight and consideration to the data of the Declaration (under 37 C.F.R. § 1.132) of Tatsuo TSUNEKA dated May 9, 2006, based on a position that the declaration does not show a comparison with the process of Ashihara, is improper. The data provides a comparison to the closest prior art, which is closer to the present invention than Ashihara. Therefore, applicants do not need to submit additional comparative data, as suggested in the present action, showing that it is not possible to obtain a dispersion from the teachings of Ashihara in the absence of an ethereal solvent. (Moreover, as explained below, the Declaration (under 37 C.F.R. § 1.132) of Tatsuo TSUNEKA does provide a proper comparison with Ashihara and shows that it is not possible to obtain a dispersion from the teachings of Ashihara in the absence of an ethereal solvent).

For this reason also, the rejection is improper and should be removed.

- (3) COMPARATIVE EXPERIMENT 2 OF THE DECLARATION (UNDER 37 C.F.R. § 1.132) OF TATSUO TSUNEKA DATED MAY 9, 2006, PROVIDES A PROPER COMPARISON WITH THE PROCESS OF ASHIHARA

Comparative Experiment 2 of the Declaration (under 37 C.F.R. § 1.132) of Tatsuo TSUNEKA dated May 9, 2006, and submitted with

the response filed May 22, 2006, to the Action of December 21, 2005, provides a proper comparison with the process of Ashihara. Comparative Experiment 2 in the Declaration shows that when water is added to a solution of an acid-modified chlorinated polyolefin in toluene (an organic solvent as disclosed in Ashihara) before neutralization, it is impossible to obtain a dispersion (aqueous resin dispersion composition). The data of the 132 Declaration of Tatsuo TSUNOKA, therefore, rebut any *prima facie* obviousness alleged by the Office to be supported by the combination of Ashihara and Verardi.

For this reason also the 35 U.S.C. § 103 rejection of claims 6 to 11 should be removed.

Issuance of a Notice of Allowance and Notice of Allowability is also believed to be in order and is respectfully solicited.

The foregoing is believed to be a complete and proper response to the Office Action dated November 8, 2006, and is believed to place this application in condition for allowance. If, however, minor issues remain that can be resolved by means of a telephone interview, the Examiner is respectfully requested to contact the undersigned attorney at the telephone number indicated below.

In the event that this paper is not considered to be timely filed, applicants hereby petition for an appropriate extension of

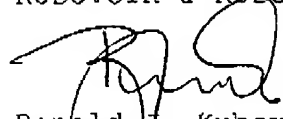
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time. The fee for any such extension may be charged to our Deposit Account No. 111833.

In the event any additional fees are required, please also charge our Deposit Account No. 111833.

Respectfully submitted,  
KUBOVCIK & KUBOVCIK



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